

R E M A R K S

Supplemental Information Disclosure Statement

Applicants filed a Supplemental Information Disclosure Statement on January 6, 2003. Applicants have requested in the past that a copy of the Form 1449 be returned to Applicants, indicating that the Examiner has considered the references cited therein; such confirmation does not appear to have been received, however. Applicants submit herewith a duplicate copy of Form 1449 and request again that acknowledgement of this document be returned. As noted previously, EP 1 038 927 A2, identified in the Supplemental Information Disclosure Statement, appears to be related to U.S. Patent No. 6,362,267 B1 and WO 00/52105 to U.S. Patent No. 6,399,689 B1.

Newly Added Claims

The Office Action indicates that Claims 51 and 52, submitted with an RCE and Amendment, are "directed to an invention that is independent or distinct from the invention originally claimed . . ." More specifically, the Office Action indicates that the originally claimed invention is directed to a coating composition, while the invention encompassed by Claims 51 and 52 is directed to a curable powder coating. A curable powder coating *is* a coating composition. Moreover, Claim 14, which depends from Claim 1 and has already received an action on the merits, is specifically directed to a powder coating. A search for the subject matter of this claim would therefore have uncovered art relevant to newly added Claims 51 and 52, also directed to a powder coating. It is therefore submitted that Claims 51 and 52 should be considered in the pending case.

Rejections Under 35 USC 102(b)

Claims 1-7, 9, 13 and 15-27 were rejected under 35 USC § 102(b) as allegedly being anticipated by Stubbs et al. (U.S. Patent No. 5,595,578). This rejection is respectfully traversed.

Claim 1, from which all of the other claims rejected on this basis depend, directly or indirectly, recites that there is a difference between the refractive index of the resin and the refractive index of the particles, and that difference is less than 1. The Office Action concedes that the art fails to mention this refractive index differential. "Nonetheless, following the reasonings stated earlier, it is proper to assume that prior art composition satisfies this limitation also unless proved otherwise." (Office Action at page 4.) Applicants describe at page 12, lines 16-25, for example, the concept of minimizing the difference in refractive indices. Stubbs does not remotely teach or suggest that his very specific resin, namely a hot melt polyurethane, and any of the particles he discloses would have a refractive index differential. Applicants respectfully request clarification on "the reasoning stated earlier", which purportedly establishes a *prima facie* case of anticipation.

Claims 1-7, 9, 13, 15-27 and 30-33 were rejected under 35 USC § 102(b) as being allegedly anticipated by Samuelson (U.S. Patent No. 4,048,765). This rejection is respectfully traversed.

Samuelson is said to teach a polishing wheel on which is deposited a coating. Applicants respectfully disagree. What Samuelson appears to teach is a cast urethane polishing wheel in which is dispersed abrasive particles. Samuelson does not remotely anticipate the claims rejected under this basis.

Rejections Under 35 USC § 103(b)

Claims 1-7, 9-27, 29, 42-50 and 53-58 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Stubbs; Claims 1-7, 9-33, 42-50 and 53-58 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Samuelson. These rejections are respectfully traversed.

Regarding Claims 10-12, which recite particular forms and/or sizes of particles, the Office Action concedes that the cited references are silent as to these types of particles. (The Office Action mistakenly refers to these particles as "aluminum" rather than alumina.) The Office Action concludes that since the specifically recited types of alumina are known, it would have been obvious to have

used them in the present coatings. There is no teaching or suggestion in either of the references, however, to use these specifically recited particles in the manner claimed. There must be some teaching or suggestion in the cited art to point one in the direction of the claimed invention; such teaching is lacking.

Regarding Claims 42-50, the Office Action further concedes that the recited invention is "not specifically mentioned by either of the two references" but that "since the claim composition is disclosed by the references, it is reasonable to infer, unless proved otherwise, that the composition of either reference, inherently satisfies these limitations." While Claims 42-44 recite properties, Claims 45 and 50 do not, and Claims 46-49 were canceled. Clarification on the basis of the rejection of Claims 42-44, 45 and 50 is therefore requested.

Regarding the remaining claims rejected under these bases, the Office Action states that "disclosure of these two patentees, presented earlier, prove that it would have been obvious to follow their teachings and arrived at the above-claimed invention." Applicants respectfully request clarification on how the references would specifically teach or suggest the claimed invention to one skilled in the art; absent such explanation, it is submitted that a *prima facie* case of obviousness has not been met.

Finally, Claim 8 was rejected under 35 USC § 103(a) as allegedly being unpatentable over Stubbs or Samuelson and further in view of Diener et al. (U.S. Patent No. 5,614,250). This rejection is respectfully traversed. Diener is used to allegedly overcome the shortcomings of Stubbs and Samuelson, which fail to disclose the three types of silica recited in Claim 8. Diener, however, appears to teach use of silica coated with fluorosilane; Applicants respectfully request clarification as to where Diener teaches crystalline silica, amorphous silica, precipitated silica or mixtures thereof as recited in Claim 8, and where there exists motivation to combine Diener with either Stubbs or Samuelson to arrive at the present invention.

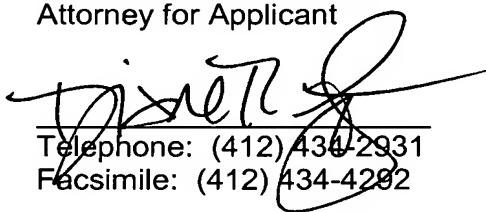
Serial No.: 10/007,149
December 5, 2001

Summary

Acknowledgement of the Supplemental Information Disclosure Statement is respectfully requested. Claims 51 and 52 should be included in the present case. Finally, the art of record has not been demonstrated as rendering the present claims anticipated or obvious. For all of these reasons, it is submitted that the claims are in condition for a Notice of Allowance.

Respectfully submitted,

DIANE R. MEYERS
Registration No. 38,968
Attorney for Applicant



Telephone: (412) 434-2931
Facsimile: (412) 434-4202

Pittsburgh, Pennsylvania
October 19, 2004